

Official

7/10/03

REMARKS

In response to the Office Action dated January 10, 2003, the period for response to which is extended by three months to July 10, 2003 by the accompanying petition under 37 C.F.R. 1.136(a), no amendments are offered. Claims 1-42 remain in the application. Reexamination and reconsideration of the application, as amended, are respectfully requested.

Rejections Under 35 U.S.C. §§ 102 and 103

In paragraphs 2-3 of the Office Action, claims 1-35, 38, and 39 were rejected under 35 U.S.C. § 102(e) as being anticipated by U.S. Patent No. 6,338,082 to Schneider.

In paragraphs 4-5 of the Office Action, claims 36, 37, and 40-42 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Schneider.

The Applicants respectfully traverse the rejections in light of the discussion below.

The Schneider Reference

The primary reference cited against the present claims is U.S. Patent No. 6,338,082 to Schneider (the Schneider patent). Applicants note that the Schneider patent is based on a number of section 111(b) priority applications, and it is only through those priority applications that the Schneider patent can be considered prima facie prior art to the present invention. The Office Action failed to provide copies of any of these priority applications. In light of the fact that there are a series of such priority patent applications, it is abundantly clear that they differ from the text of the Schneider patent. As such, it is the merest speculation that

these priority applications present any teachings relevant to the present disclosure. This leaves the applicants in the wholly unfair position of having to argue for the patentability of their invention without having the asserted prior art before them.

It further appears that there may be a misunderstanding of the Schneider patent. On page 2, the Office Action states "Schneider discloses a plurality of modifiable domain name records in a database in concurrence with a DNS root server (120' fig. 1a)." This is mistaken. The Schneider patent discusses nothing about the DNS root servers. Rather, as made clear at column 9, lines 45-56, the Schneider patent is referring to the "large number of name servers" at the opposite end of the DNS system hierarchy from the DNS root servers. The Schneider patent accurately states that the DNS system is hierarchical. Schneider patent, col. 9, ll. 45-46. At one end of the hierarchy are the thirteen DNS root servers discussed at lines 26-28 of page 2 of the present application. At the other end of the hierarchy are the "large number" of DNS name servers 120' discussed by the Schneider patent. Consequently, the Office Action errs in identifying the Schneider patent as discussing a DNS root server. All that the Schneider patent does with the DNS name servers is check on a domain name's availability.

This is an important issue. The system and method described in the present application provides for authoritative domain name registration or management, which is done through an interface with one of the DNS root servers. Authoritative registration or management is not accomplished with the large number of DNS name servers.

What the Schneider patent describes is a system that determines if a particular domain name is currently registered (in one or more DNS name servers). Only single names are considered, in response to the user entering a domain name into a browser and to attempt to contact the entered domain name. If the domain name is not currently registered, the user is offered the opportunity to fill out a form to apply to register that domain name. All that is done is fill out the form. See Schneider patent, col. 13, ll. 22-25 ("the user completes a NIC registration form in

step 360. The form is then submitted in step 364 to the proper NIC authority for processing.”); col. 13, ll. 43-45 (a registration form is displayed (as in step 360) as a result of processing the registration request in step 410.”); and col. 16, ll. 3-6 (“the completed NIC registration form can be sent to such a registrar and processed in a way that is transparent to the user and does not interfere with the current user’s on-line navigational session.”). Presumably the form is filled out on the user’s computer and forwarded to the registrar by e-mail, but that is not clear from the teachings of the Schneider patent.

There is no suggestion in the Schneider patent of a method of managing multiple domain names. Rather, the Schneider patent is directed to a service for offering individuals the opportunity to apply for a registration when the user happens to enter a domain name that is not registered.

The Claims are Patentable over the Schneider Patent

The present invention is directed towards a method of administering a plurality of modifiable domain name records in a database in concurrence with a DNS root server, where the database stores first and second records corresponding to a first domain name and a second domain name, respectively. With reference to an embodiment related to claim 1, the application describes a method that accepts a command from a client machine to modify a first domain name record and replace it with a modified record. For example, the contact information associated with a first domain name might be changed. The method then allows the user to apply that same change easily to a second domain name record. After the desired changes are made, the method then causes those changes to be propagated to the DNS root servers.

Claim 1 reflects this embodiment by reciting: “storing the modified record in place of each of the first and second records in the database; and causing the records in the DNS root server to be substantially in agreement with the modified database records.” This allows the efficient management of a number of domain names at

Official

12/10/03

once. Nothing similar is described in the Schneider patent, which deals only with offering the opportunity to fill out an application form for a happenstance entered domain name. None of the other references of record teach or suggestion the invention of claim 1. As such, claim 1 and its dependent claims 2-13 distinguish over the art of record and are in condition for allowance.

Claim 14 is directed to a method that uses a graphical user interface to first show current information related to a domain name record and then show a user's changes to that record. The changes are then made in the DNS root server. As discussed above, the Schneider patent does not discuss or suggest anything with respect to the DNS root servers. In addition, the Schneider patent does not describe anything about presenting a current domain name record on a graphical user interface. Rather, the Schneider patent displays a NIC form to fill out to apply for a registration. There is no interface to any sort of database in the Schneider patent.

Consequently, claim 14 and its dependent claims 15-33 distinguish over the art of record and are in condition for allowance.

Claim 34 is directed to a computer program that uses a graphical user interface to first show current information related to a domain name record and then show a user's changes to that record. The changes are then made in the DNS root server. As discussed above, the Schneider patent does not discuss or suggest anything with respect to the DNS root servers. In addition, the Schneider patent does not describe anything about presenting a current domain name record on a graphical user interface. Rather, the Schneider patent displays a NIC form to fill out to apply for a registration. There is no interface to any sort of database in the Schneider patent.

Consequently, claim 34 and its dependent claims 35-42 distinguish over the art of record and are in condition for allowance.

Conclusion

In view of the foregoing, it is respectfully submitted that the application is in condition for allowance. Reconsideration of the application and entrance of these amendments are respectfully requested.

If for any reason the Examiner finds the application other than in condition for allowance, the Examiner is requested to call the undersigned attorney at the Los Angeles, California telephone number (213) 337-6742 to discuss the steps necessary for placing the application in condition for allowance.

If there are any fees due in connection with the filing of this response, please charge the fees to our Deposit Account No. 50-1314.

Respectfully submitted,

HOGAN & HARTSON L.L.P.

By: 

William H. Wright
Registration No. 36,312
Attorney for Applicant(s)

Date: July 10, 2003

500 South Grand Avenue, Suite 1900
Los Angeles, California 90071
Phone: 213-337-6700
Fax: 213-337-6701